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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/888,822 | 06/22/2001 | Raymond J. Werner | 71062.P001 | 9731 |
| 25943 | 7590 | 11/10/2004 | EXAMINER | |
| SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITES 1600-1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204 | | | HENNING, MATTHEW T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2131 | |

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/888,822 | WERNER, RAYMOND J. |
| | Examiner Matthew T Henning | Art Unit 2131 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 June 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) 3, and 14 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ |

This action is in response to the communication filed on 06/22/2001.

DETAILED ACTION

1. Claims 1-17 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 06/22/2001.

Drawings

5. The drawings filed on 09/18/2001 are acceptable for examination proceedings.

Claim Objections

6. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

7. Claim 3 is objected to because of the following informalities: Lines 1-2 recite "Gloobal Positioning System" which should read Global Positioning System. Appropriate correction is required.

8. Claim 14 objected to under 37 CFR 1.75(c), as being of improper dependent form for depending from itself. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The examiner, for purposes of searching prior art, will assume that the claim was meant to depend on claim 13.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 4-7, 13-14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Madison (US Patent Application Publication Number 2002/0023123).

11. Claim 1 recites a method of providing location history to computer files, comprising: opening a file (See Madison Paragraph 0010 Lines 4-5); reading location information from a location information resource (See Madison Paragraph 0010 Lines 6-10); and writing the location information to the file (See Madison Paragraph 0007 Lines 3-7).

12. Claim 2 recites that the location information resource is a peripheral device in a computer system (See Madison Paragraph 0015).

13. Claim 4 recites that opening the file comprises one or more operations by a computer operating system (See Madison Paragraph 0015).

14. Claim 5 recites that the location information comprises latitude and longitude (See Madison Paragraph 0015 Lines 8-10).

15. Claim 6 recites that the location information comprises one or more geographical place names (See Madison Paragraph 0015 Lines 8-10).

16. Claim 7 recites reading the location information previously written to the file (See Madison Paragraph 33 Lines 8-11).

17. Claim 13 recites a method of obtaining information about the geographical pattern of client usage of a web site, comprising: creating a file on a client computer in connection with an interaction with a web server (See Madison Paragraph 0015); reading location information from a location information resource in the client computer (See Madison Paragraph 0014); storing the location information in the file (See Madison Paragraph 0015).

18. Claim 14 recites that the file is a cookie file (See Madison Paragraph 0015).

19. Claim 16 recites comprising reading location information from the file and communicating that location information to the web server (See Madison Paragraph 33 Lines 8-11).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madison as applied to claims 2 and 13 above, and further in view of Bickley et al. (US Patent Number 5,519,403) hereinafter referred to as Bickley.

Madison disclosed providing location information about a computer (See Madison Abstract), but failed to disclose generating the location information using a GPS module.

Bickley teaches that GPS is the most accurate positioning technology (See Bickley Col. 1 Lines 29-30).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Bickley in the computer locating system of Madison by providing location information via a GPS module rather than a telephone number lookup. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the most accurate location information available.

22. Regarding claim 17, See Madison Paragraph 33 Lines 8-11.

23. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. (US Patent Number 6,526,436) hereinafter referred to as Shiraishi, and further in view of Padwick ("Using MICROSOFT OUTLOOK 98").

Regarding claim 8, Shiraishi disclosed a method of incorporating geographical information in an email, comprising: a) receiving, in a computer system, a command to send an email (See Shiraishi Col. 4 Lines 10-12); and b) reading location information from a location information resource within the computer system (See Shiraishi Col. 3 Lines 56-67), and

inserting the location information into a signature block of the email (See Shiraishi Col. 4 Lines 12-32). However, Shiraishi failed to disclose determining if an automatic signature feature is active for the email, and sending the email without the location information if the determination is negative.

Padwick teaches that, in an E-mail system, signatures may or may not automatically be added to outgoing e-mail depending on the preference of the user (See Padwick Page 312).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Padwick in the E-mail location signature system of Shiraishi in order to determine whether the location signature would be added to an outgoing E-mail. This would have been obvious because the ordinary person skilled in the art would have been motivated to allow users preferences to be reflected in the E-mail.

24. Regarding claim 9, Shiraishi disclosed that the location information resource is a GPS module (See Shiraishi Col. 6 Lines 3-5).

25. Regarding claim 10, Shiraishi disclosed that the location information comprises latitude and longitude (See Shiraishi Col. 6 Lines 5-9).

26. Regarding claim 11, Shiraishi disclosed that the location information comprises geographical place name information (See Shiraishi Col. 6 Lines 9-12).

27. Regarding claim 12, Shiraishi disclosed converting latitude and longitude information into geographical place name information (See Shiraishi Col. 6 Lines 9-12).

Conclusion

28. Claims 1-17 have been rejected.
29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. MacDoran et al. (US Patent Number 5,757,916) disclosed a method for authenticating the location of a computer using GPS technology.
 - b. Feinberg (US Patent Application Publication Number 2001/0053999) disclosed a system for providing geographically oriented information to a client device by using GPS to track the location of the client device.
30. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (571) 272-3790. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



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Art Unit 2131



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